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PATENT  
Attorney Docket No.: 016770-004300US

Assistant Commissioner for Patents  
Washington, D.C. 20231

On 12-3-01

TOWNSEND and TOWNSEND and CREW LLP

By: Connie Larson

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OFFICE OF PETITIONS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Sharad Narayan et al.

Application No.: 09/812,988

Filed: March 20, 2001

For: METERING PUMPS FOR AN  
AEROSOLIZER

Examiner: Unknown

Art Unit: 3761

PETITION TO ACCEPT APPLICATION  
ON BEHALF OF A JOINT INVENTOR  
WHO REFUSES TO JOIN IN AN  
APPLICATION UNDER 37 CFR § 1.47(a)

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Applicants hereby petition the Commissioner to accept the above-referenced application on behalf of Miro S. Cater, a joint inventor, who refuses to join in the application. As required by MPEP 409.03(a), accompanying this petition is:

(A) A declaration that is signed on behalf of Miro S. Cater by leaving the signature block of Miro S. Cater blank while containing the signature of each of the other joint inventors;

(B) A DECLARATION SUPPORTING PETITION FOR FILING OF PATENT APPLICATION WHEN ONE JOINT INVENTOR REFUSES TO EXECUTE PAPERS UNDER 37 CFR § 1.47(a) demonstrating that Miro S. Cater refuses to execute the application papers; and



(C) The last known address of Miro S. Cater: 1777 Mitchell Court, Daytona Beach, Florida, 32124.

Please deduct the fee of \$130.00 as set forth in 37 CFR § 1.17(h) for filing this Petition. Also enclosed is a Request for Extension of Time. Please deduct the fee of \$1960.00 as set forth in 37 CFR § 1.17(a)(5) for filing an extension of time.



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Reg. No. 38,464

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DECLARATION SUPPORTING  
PETITION FOR FILING OF PATENT  
APPLICATION WHEN ONE JOINT  
INVENTOR REFUSES TO EXECUTE  
PAPERS UNDER 37 CFR § 1.47(a)

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

The following statement establishes the refusal by one of the inventors, MIRO S. CATER, to execute the application documents for the present application and the need for filing the instant petition, under 37 CFR §1.47(a), for which this statement is submitted.

As a matter of record, the present application is a continuation-in-part of U.S. Patent Application No. 09/313,941 ("the '941 application"), filed May 18, 1999 in which the same individual, Miro S. Cater, is an inventor and in which Mr. Cater executed a declaration and an assignment to AeroGen, Inc. ("Aerogen"), the present assignee, both executions dated July 19, 1999.

Also of record, the '941 application itself is a continuation-in-part of U.S. Patent Application No. 09/149,426 ("the '426 application"), filed September 8, 1998 (now U.S.

Patent No. 6,205,999), in which Mr. Cater is an inventor and in which Mr. Cater executed a declaration and an assignment to Aerogen, both executions dated October, 28, 1998.

Also of record, the '426 application is itself a continuation-in-part of U.S. Patent Application No. 09/095,737 ("the '737 application"), filed June 11, 1998 (now U.S. Patent No. 6,014,970), in which Mr. Cater is an inventor and in which Mr. Cater executed a declaration and an assignment to Aerogen, both executions dated July 24, 1998.

Upon information and belief, the present application (as well as each of the above listed parent applications) was prepared with the help of the other inventors by and with the assistance of counsel of record in this case, Townsend and Townsend and Crew, counsel for assignee Aerogen.

Based on my personal knowledge, each of the other inventors reviewed the present application and executed a declaration and an assignment of the invention and of the present application to Aerogen.

On July 19, 2001, I contacted Mr. Miro Cater by telephone to verify his current address so that I could send him a copy of the application, a declaration and an assignment for his review and execution. Mr. Cater verified to me his address of 1777 Mitchell Court, Daytona Beach, Florida, 32124. On that same day I sent to Mr. Cater, by overnight courier to this address, a copy of the application, a declaration and an assignment.

On August 6, 2001, I again contacted Mr. Cater by telephone. Mr. Cater informed me that he had received the application, the declaration and the assignment. Mr. Cater indicated that he understood the content of the application. Mr. Cater indicated that he was unwilling to sign the declaration or assignment. I reminded Mr. Cater of a consulting agreement, which Mr. Cater had executed June 1, 1997 ("the consulting agreement"), between him and Aerogen that, among other things, assigned to Aerogen his interest in the subject matter set forth therein on which the present application (as with each of the parent applications) is based and obligated Mr. Cater to cooperate with Aerogen in executing further documents for use by Aerogen in applying for and obtaining patents. Based on information and belief, a true and correct copy of the consulting agreement is attached hereto as Exhibit 1. Mr. Cater indicated in this telephone discussion that he understood the consulting agreement but that he was unwilling to execute the declaration or the assignment.

Mr. Cater indicated that he questioned the patentability of the claimed invention and that he thought the subject matter had been previously invented by him and was in a prior patent of his. I explained to Mr. Cater that his prior patents would be disclosed to the Patent Office, as would any other subject matter that should be disclosed to the Patent Office in accordance with Patent Office rules, and that the patentability of the claimed invention would be determined by the Patent Office through the examination process. When asked, Mr. Cater did not identify any specific patent of his as incorporating the subject matter of the present application nor did he identify or articulate any other art or patent in addition to those patents that he had listed in Exhibit B to the consulting agreement (Exhibit 1).

Mr. Cater further stated that he had assigned such patents to a company known as Samova that had been subsequently purchased by another company known as Pfeiffer, which is his current employer. Mr. Cater indicated that he felt there might be repercussions from his employer, Pfeiffer, if he were to execute the assignment and declaration. I stated to Mr. Cater that even if it were the case that Pfeiffer owned his prior patents, such ownership would not be a basis for Aerogen to relinquish its rights to the present application and that Mr. Cater had continuing obligations to Aerogen for his prior work under the consulting agreement.

Mr. Cater made statements to the effect that he did not want to sign the assignment or declaration unless he were to have either his own patent lawyer or his present employer, Pfeiffer, tell him that he should do so. I told Mr. Cater that I would be happy to discuss the matter with Mr. Cater's patent attorney, but Mr. Cater declined to either give any name of any counsel or state whether he actually had any such counsel or planned to in the future; at no time in this discussion or at any time since then has Mr. Cater indicated that he was represented by counsel. Mr. Cater did state that he wanted his present employer, Pfeiffer, to reach an accord with Aerogen as a prerequisite to his execution because, as he put it, he had "spent many hours in the witness chair" because of things he had signed.

On October 23, 2001 I again spoke with Mr. Cater by telephone. Mr. Cater indicated that he thought Pfeiffer had requested that Aerogen cancel claims from the application as a condition for Pfeiffer to advise Mr. Cater to execute the declaration and assignment. Mr. Cater clearly indicated that he would only be willing to execute the documents for the present application if his present employer, Pfeiffer, would give him a go

ahead to do so, but if that was not the case, then he would not. Mr. Cater summed up the discussion by saying that if his employer Pfeiffer had not reached an agreement with Aerogen then “nothing has changed” since our prior telephone conference and that he would not execute the declaration or the assignment for the present application.

On November 20, 2001 I joined in a telephone conference with Mr. Cater and several Pfeiffer personnel, including a Mr. Ritsche. Mr. Cater indicated that he would not execute the declaration or the assignment. For reasons, Mr. Cater stated that he thought some of the claims included subject matter that he had previously given to Samova and that Pfeiffer came to own. Mr. Cater alluded to subject matter described in letters between him and Aerogen that were prior to the execution of his consulting agreement with Aerogen. Subsequent to this telephone conference I searched Aerogen’s corporate records for such letters and I could find no such letters or any correspondence describing any art other than the patents listed on Exhibit B to the June 1, 1997 consulting agreement. Addressing this issue in the November 20, 2001 telephone conference, I pointed out to Mr. Cater that in the consulting agreement (Exhibit 1) that he executed, Mr. Cater had covenanted that he had provided in that consulting agreement a complete list of his prior inventions. I again asked Mr. Cater to provide me with any other prior art of which he is aware presently or in the future.

Mr. Cater reiterated his concern that he believed some of the claims of the present application should belong to Pfeiffer. Mr. Ritsche stated that neither he nor anyone at Pfeiffer (other than Mr. Cater) had seen the present application. Nonetheless, Mr. Ritsche stated his view that Pfeiffer did not want Aerogen to own certain claims of the present application and that he thought such claims should belong to Pfeiffer.

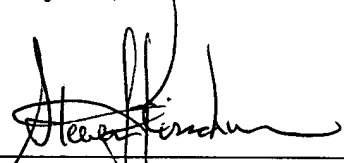
Mr. Cater and Mr. Ritsche explicitly stated that they would agree that Mr. Cater would execute the documents for the present application if there were to be an agreement between Aerogen and Pfeiffer by which Aerogen would relinquish ownership of certain of the patent claims in view of Pfeiffer’s position that it did not want Aerogen to have rights in such patent claims. Mr. Ritsche indicated that if there were to be no such agreement, Pfeiffer would not agree to Mr. Cater executing the present application documents. Mr. Cater indicated that if there were to be no such agreement, he would not execute the patent application documents.

I stated to Mr. Cater that if he were unwilling to sign the present application documents, Aerogen would proceed with the application on that basis. Mr. Cater indicated that he would not execute the present application documents.

Based on the foregoing, I understand that the inventor Miro S. Cater, whose last known address is 1777 Mitchell Court, Daytona Beach, Florida, 32124, is unwilling to execute a declaration for the present application. I understand the foregoing to establish the basis for the accompanying Petition For Filing Of Patent Application When One Joint Inventor Refuses To Execute Papers Under 37 CFR § 1.47(a).

I hereby declare that all statements made herein of my own knowledge are true and all statements made herein on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment or both under 18 U.S.C. 1001, and may jeopardize the validity of the application or any patent issuing thereon, and I make this declaration under penalty of perjury under the laws of the United States.

Executed on November 29, 2001, at Sunnyvale, California.

  
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Steven J. Kirschner  
Director of Intellectual Property  
and Senior Patent Counsel  
AeroGen, Inc.

Reg. No. 35,573

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